

Application No.: 10/079,443

Docket No.: 064422-5002US

REMARKS

Claims 1-38 are pending. Claims 16-38 are canceled without prejudice as directed to a nonelected invention. Claims 1-15 are rejected. Claim 1 has been amended. No new matter has been added as a result of this amendment. Applicants reserve the right to prosecute the canceled claims and/or the subject matter contained therein, in one or more divisional/ continuation applications.

RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-15 are rejected under 35 U.S.C. § 112 as being indefinite. According to the Examiner, the phrase "of step D" in claim 1, line 11 has no antecedent basis. Applicants respectfully note that in the originally submitted claims, line 7 of claim 1 recites a step (D) and thus provides the appropriate antecedent basis. Additionally, claim 1 (as originally written) does not comprise a line 11. Applicants therefore respectfully request withdrawal of the indefiniteness rejection.

RESPONSE TO REJECTION UNDER 35 U.S.C. § 102/103(a)**Legal Principles**

Under the patent statute, a patent claim is invalid if the claimed invention is anticipated by a prior art reference under 35 U.S.C. § 102. The Federal Circuit has held that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Spada*, 911 F.2d 705, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1988); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1665, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991) (emphasis added).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

A Motivation to Combine Must Be Shown

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). A mere conclusory statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The Federal Circuit in *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001), noted that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art. *Id.* at 1697. In other words, *In re Zurko* expressly proscribes any reliance by an examiner on what constitutes the knowledge of one skilled in the art, when the assessment of that knowledge is not based on any evidence in the record. More recently, the Federal Circuit reiterated this position in *In re Lee*, where it took issue with the fact that "neither the examiner nor the Board adequately supported the selection and combination of the ... references to render obvious that which [patentee] described." *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

If a proposed modification would render the prior art teaching being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

There Must Be a Reasonable Expectation of Success

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The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). Evidence showing that there is no reasonable expectation of success supports a finding of nonobviousness. *In re Rinehart*, 531 F.2d 1048 (C.C.P.A. 1976).

All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). In other words, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Argument

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Narula et al. (US 6146602) in view of Benazzi et al. (US 5695735). Applicants respectfully note that neither of the references, either individually nor in combination, teach suggest the use of a first compound possessing amphipathic properties in the synthesis of a mesoporous compound. Furthermore, claim 1 as currently amended recites that the claimed first compound is capable of forming a micellar structure. Neither of the cited references teaches or suggests the use of a first compound that is capable of forming a micellar structure. In sum, the combination of the references does not teach or suggest all of the claim limitations. Thus, the criteria for a finding of obviousness as set forth above, have not been met. Hence Applicants respectfully request the withdrawal of the rejection.

Conclusion

In view of the above amendments and arguments, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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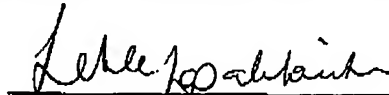
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No fees are believed to be due in connection with this paper. However, if any fees are due, the Commissioner is authorized to charge the required fee in connection with this paper to our Deposit Account No. 50-0310 (064422-5002US).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



Lekha Gopalakrishnan
Reg. No. 46,733

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MORGAN, LEWIS & BOCKIUS LLP
1717 Main Street, Suite 3200
Dallas, Texas 75201-7347
Tel: 214.466.4116
Fax: 214.466.4001